



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/917,384

07/28/2001

William S. Adney

NREL 01-38

9964

23712 7590 04/30/2007

PAUL J WHITE, SENIOR COUNSEL  
NATIONAL RENEWABLE ENERGY LABORATORY (NREL)  
1617 COLE BOULEVARD  
GOLDEN, CO 80401-3393

EXAMINER

RAO, MANJUNATH N

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

04/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/917,384

Applicant(s)

ADNEY ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 19-21, 23-25, 31-34, 69-74 and 78-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 19-21, 23-25, 31-34, 69-74, 79-80 is/are rejected.
- 7) ☒ Claim(s) 7-11 and 78 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-11, 19-21, 23-25, 31-34, 69-74, 78-80 are currently at issue and are present for examination.

Applicants' amendments and arguments filed on 2-8-07, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Examiner acknowledges applicant's response to the previous sequence compliance issue. Examiner has withdrawn the previous rejection of claims under 35 U.S.C. 101 and under 35 U.S.C. 112, 1<sup>st</sup> paragraph (non enablement) in view of claim amendments.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6, 19-21, 79-80 and claims 2-5, 23-25, 31-34, 69-74 depending therefrom are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 6, 19-21, 79-80 are drawn to polypeptide sequences that are "about 95%" or "about 98%" identical to SEQ ID NO: 1, 2, 4, 5, 6, 7. However, a perusal of the specification indicates that applicants have no support for the newly added language which now constitutes a "new matter". Therefore claims 1, 6, 19-21, 79-80 and claims 2-5, 23-25, 31-34, 69-74 depending therefrom are

Art Unit: 1652

rejected for introducing "new matter" into the claims. A perusal of the specification indicated support for only "90% identity" language and that too for only SEQ ID NO: 1 (page 18 of the specification).

In response to the previous Office action applicants argue that adding back the phrase "at least" to modify the percent identity addresses the Examiner's concern regarding support for said amendment. Applicants argue that the phrase "at least" in plain language means "not less than" and thus, when the description points out a percent identity of "at least about 90%", the plain language interpretation means "not less than 90%". Applicants argue that, "at least about 90%" is the same as anything above and about 90%. However, applicants also maintain that the drafter of the patent application could have said "about 90%, or about 91%, or about 92%, or about 93%, or about 94%, or about 95% ..." but it's a common form of the English language to say "at least about 90%" as an efficient way of describing the same thing. Examiner respectfully disagrees. Adding back the phrase "at least" does not remedy the "new matter" rejection. The question here is what the applicants chose to claim at the time this application was filed. At the time of filing this application, applicants specifically chose to exclude all those polypeptides that are more than 90% identical the sequences in question. However, they are now contemplating on claiming sequences that were not contemplated on being claimed at the time of filing this application. Therefore, without an explicit recitation of all the per cent homologies or per cent identities of sequences as support for the claim amendments that were contemplated at the time this application was filed, reciting them at this stage in the prosecution of the application raises the issue of "new matter".

Art Unit: 1652

Examiner also respectfully disagrees with respect to the applicant's argument regarding the interpretation of the decision handed down in *In re Wertheim*. Applicants themselves point out in *In re Wertheim*, the original specification described a set range of 25% to 60% and the new limitation added "at least 35%", fell within that range. However, in this case, the fact pattern is different in that the added new limitation is outside the limit of per cent homologous sequence contemplated at the time of filing this application. Therefore, applicant's conclusion that the fact pattern of the case in which the decision of *In re Wertheim* was handed down and the fact pattern of this instant case is the same is highly erroneous. For all the above reasons the above rejection is maintained.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 4-18-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the patents issued for applications 09/917383 and 09/917378 has been reviewed and is accepted. The terminal disclaimer has been recorded. In view Of the above TD the previous Obviousness Double patenting rejection is hereby withdrawn.

#### ***Conclusion***

None of the claims 1, 6, 19-21, 79-80 and claims 2-5, 23-25, 31-34, 69-74 depending therefrom are allowable.

Art Unit: 1652

Claims 7-11, 78 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

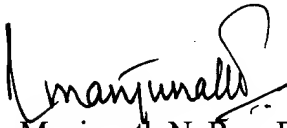
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of

Art Unit: 1652

this application or proceeding should be directed to the receptionist whose telephone number is  
571-272-1600.

A handwritten signature in black ink, appearing to read 'Manjunath N. Rao', with a stylized flourish at the end.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

April 23, 2007